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21043-87

CERTIFICATE OF MAILING

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Joseph W. Luciano

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Joseph W. Luciano et al. :
Serial No.: 09/609,891 : Group Art Unit: 2624
Filed: July 5, 2000 : Examiner: G. Garcia
For: **Photoprinter Control of**
Peripheral Devices :

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, DC 20231

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Dear Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed by Certificate of Mail on July 18, 2002 and received by the U.S. Patent and Trademark Office on July 23, 2002.

I. REAL PARTY IN INTEREST

The real party in interest in this Appeal is the assignee of the present application, Lexmark International, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellants, the Appellants' undersigned legal representative or the assignee which will directly effect or be directly effected by or having a bearing on the Board's decision in the present appeal. While the

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assignee believes there are no other appeals which will directly effect or be directly effected by or have a bearing on the Board's decision, the following applications of the assignee relating to stand-alone printers are also under appeal: 09/610,129; 09/610,249; 09/610,081; and 09/610,404.

III. STATUS OF THE CLAIMS

Claims 1-2 and 6-23 are pending and stand rejected. Claims 3-5 have been cancelled.

A copy of the pending claims is set forth in the Appendix.

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

An First Amendment Under 37 C.F.R. §1.116 was submitted by Certificate of Mailing on July 18, 2002. The Advisory Action dated August 16, 2002 indicated that the Amendment will not be entered. A Second Amendment under 37 CFR §1.116 is submitted herewith. In the Amendment, claims 3-5 are cancelled in order to reduce the issues on appeal. The Appendix submitted herewith does not incorporate the amendments set forth in the First Amendment under 37 C.F.R. §1.116, but does incorporate the Amendments set forth in the Second Amendment under 37 C.F.R. §1.116. In the event that the Examiner does not enter the Second Amendment under 37 C.F.R. §1.116, a revised Appendix will be provided.

V. SUMMARY OF THE INVENTION

The claimed invention is directed to a configuration involving stand-alone printer apparatuses and methods for using the same (page 1, lines 3-5 of the specification).

As set forth in independent claim 1, the claimed photoprinter configuration comprises a digital camera with a viewable display and one or more selection mechanisms, as well as a photoprinter capable of processing and printing digital files independent of an external host device. The stand-alone photoprinter is connected to the digital camera via a communication link, with the photoprinter being operative to control the viewable display of the digital camera (page 2, lines 3-9 of the specification).

Claims 2 and 6 are each dependent upon claim 1 and further define the photoprinter configurations. Claim 2 defines the photoprinter as being further operative to direct results from a user's input to the selection mechanisms (page 7, lines 3-28 of the specification). Claim 6 further defines the photoprinter as including a means for controlling the digital camera by the photoprinter (page 7, lines 3-28 of the specification).

Independent claim 7 is directed to a method for controlling a digital camera. The claimed method includes the steps of obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media; obtaining a digital camera comprising a viewable display and one or more selection mechanisms; connecting the digital camera to the photoprinter via a communication link; transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and controlling the digital camera by the photoprinter in accordance with the plurality of instructions (page 2, lines 10-16 and page 4, lines 13-21 of the specification).

Dependent claims 8-12 further define the methods of claim 7. In claim 8, the transmitted instructions are operative to preview digital photographs on the viewable display (page 4, lines 21-30 of the specification). In claim 9, the instructions are defined as being operative to present a user interface on the viewable display (page 6, lines 5-11 of the specification). According to claim 10, the instructions are operative to direct an operation of the photoprinter based on input to the selection mechanisms (page 7, lines 3-16 of the specification). Claim 11, which is dependent upon claim 10, further defines the instructions as being operative to select digital photographs for printing based on input to the selection mechanisms (page 8, lines 10-32 of the specification). In claim 12, also dependent upon claim 10, the instructions are further operative to modify a printed rendition of digital photographs based on the input to the selection mechanism (page 8, lines 22-32).

In independent claim 13, the printer configuration includes a host computer; a peripheral device; a stand-alone printer connected via a communication link to the host computer and the peripheral device. The stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a pass-through device such that the host computer may initiate requests to the peripheral device (page 2, lines 17-22 of the specification).

Dependent claims 14-20 further define the printer configurations of claim 13. According to claim 14, the stand-alone printer is a photocopier (page 3, lines 12-28 of the specification). In claim 15, the peripheral device is defined as a digital camera (page 9, lines 21-28 of the specification). In claim 16, the stand-alone printer includes a means for receiving and sending data via the communication link (page 7, lines 3-16).

According to claim 17, the communication link is a universal serial bus (page 9, lines 9-20 of the specification). Claim 18, which is dependent upon claim 17, defines the stand-alone printer as including a universal serial bus device controller, a universal serial bus host controller, a processor interface operative to control the universal serial bus device controller and universal serial bus host controller (page 10, lines 8-19 of the specification). Claim 19 requires the universal serial bus device controller and the universal serial bus host controller to share one or more FIFOs (page 10, lines 8-32 of the specification). According to claim 20, the stand-alone printer includes a universal serial bus hub (page 11, lines 1-9 of the specification).

Independent claim 21 is directed to a printer configuration that includes a universal serial bus; a stand-alone printer connected to the universal serial bus as a universal serial bus host; and a peripheral device connected to the universal serial bus as a universal serial bus device, the peripheral device being subordinate to the stand-alone printer (page 9, lines 21-33 of the specification).

Claims 22-23 further define the printer configurations of claim 21. According to claim 22, the peripheral device is a digital camera (page 9, lines 21-27 of the specification). In claim 23, the stand-alone printer is a photoprinter (page 3, lines 10-28 of the specification).

VI. ISSUES ON APPEAL

The two issues presented on appeal for review by the Board are as follows:

A. The rejection of claims 1, 2, and 6-12 under 35 U.S.C. §102(e) as being anticipated by Stephenson, U.S. Patent No. 5,949,469; and

B. The rejection of claims 13-23 under 35 U.S.C. §103 as being unpatentable over Stephenson in view of Taniguchi et al., U.S. Patent No. 5,999,707.

VII. GROUPING OF THE CLAIMS

A. With respect to the above-noted issue A on appeal, Appellants submit that claims 1, 2, 7, 8-10 and 12, are independently patentable. Claims 1 and 7, while different in form, share at least one patentable distinction over the prior art. Claim 1 has further limitations that patentably distinguish it over both the prior art and the invention defined by claim 7. Hence, claim 1 is patentably distinguishable over claim 7. The reasons in support of the independent patentability of these claims are set forth below. With respect to the above-noted issue A, Appellants concede that claim 6 stands or falls together with claim 1, from which it directly depends, and claim 11 stands or falls together with claim 10, from which it directly depends.

B. With respect to the above-noted issue B on appeal, Appellants submit that claims 18, 19 and 21 are independently patentable from claim 13. The reasons in support of the independent patentability of these claims are set forth below. Finally, Appellants concede that claims 14-17 and 20 stand or fall together with claim 13, from which they directly or indirectly depend, and claims 22 and 23 stand or fall together with claim 21, from which they directly or indirectly depend.

VIII. ARGUMENTS

As will be set forth in detail below, the printer configurations, and methods for controlling a digital camera defined by claims 1-2 and 6-23 are not anticipated by, and are nonobvious over and patentably distinguishable from, Stephenson, whether alone or in combination with Hanada or Taniguchi et al. Accordingly, the rejections of claims 1-2, and 6-23 under 35 U.S.C. §§102 and 103 should be reversed. Favorable action by the Board is respectfully requested.

A. The Claimed Photoprinter Configurations And Methods Are Not Anticipated By Stephenson

The photoprinter configurations and methods for controlling a digital camera as defined by claims 1, 2 and 6-12 are not anticipated by Stephenson.

1. The Invention

As set forth above, the present invention is directed to printer configurations and methods for controlling a peripheral device. As defined by claim 1, the photoprinter configurations comprise a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the digital camera. As defined by claim 7, the claimed method comprises the steps of (a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operable to print digital photographs onto printable media; (b) obtaining a digital camera comprising a viewable display and one or more selection mechanisms; (c) connecting the digital camera to the photoprinter via a communication link; (d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and (e) controlling the digital camera by the photoprinter in accordance with the plurality of instructions.

In conventional printers, an external host device is utilized to preview, process and print digital files by generating the print code which is then transferred to the printer. By avoiding the external host device, and being able to control the viewable display of the digital camera, the photoprinter configuration of claim 1 allows one to, for example, preview, process and print digital files without needing either an external host device or a viewable display associated with the external host device and/or the printer. Thus, such a photoprinter configuration can provide surprising and significant cost savings and advantages for printing digital photographs.

2. **The Rejection**

The Examiner asserted that Stephenson teaches a photoprinter configuration comprising: a digital camera comprising a viewable display and one or more selection mechanisms; and a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via communication link, the photoprinter being operative to control the viewable display of the digital camera.

3. **The Claimed Photoprinter Configurations And Methods Are Not Anticipated By Stephenson**

The photoprinter configurations and methods of claims 1, 2 and 6-12 are not anticipated by Stephenson and the rejection of these claims under 35 U.S.C. §102 should be reversed. Among other deficiencies, Stephenson fails to teach or disclose a photoprinter capable of processing (and printing) digital files independent of an external host device, as required by all of the claims at issue. Stephenson further lacks any teaching or suggestion of, for example, a photoprinter operative to control a viewable display of a digital camera when connected to the digital camera via a communication link; or of transmitting, from a photoprinter to a connected digital camera, instructions operative to preview digital photographs on a viewable display of the digital camera, as required by other of the claims at issue.

More particularly, as defined by independent claim 1, the claimed photoprinter configuration requires a photoprinter capable of processing digital files independent of an external host device. Claim 7 is directed to a method for controlling a digital camera. This claim requires obtaining a photoprinter capable of processing digital files independent of an external host device. As defined in the present specification and used in the claims of the present application, "processing" refers to calculating a pixel pattern to be printed on printable media that represents the corresponding digital file. (Page 3, lines 17-21 of the specification).

Stephenson discloses a printer that prints images by illuminating photosensitive media with a light image from a liquid crystal display of a camera. Stephenson, however, lacks any teaching or suggestion of a photoprinter capable of processing (and printing) digital files independent of an external host device, as required by claims 1 and 7. In fact, since the printer disclosed in Stephenson prints an image by merely exposing photosensitive media to light from a display of a camera, the printer of Stephenson has no need to process any files, let alone calculate a pixel pattern to be printed on printable media that represents a corresponding digital file.

As the Board is well aware, anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claim under consideration, *Alco Standard Corp. v. TVA*, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). In view of the failure of Stephenson to disclose a photoprinter capable of processing digital files independent of an external host device, Stephenson does not disclose each element of claims 1 and 7. Therefore, Stephenson does not anticipate the photoprinter configurations and methods defined by claims 1 and 7.

Accordingly, the photoprinter configurations and methods defined by claims 1, 2 and 6-12 are not anticipated by Stephenson, and the rejection of claims 1, 2 and 6-12 under 35 U.S.C. §102 should be reversed.

4. **Claim 1 Further Distinguishes Over Stephenson**

In addition to the distinctions over Stephenson discussed above, claim 1 requires the further limitation that the photoprinter connected to the digital camera is "operative to control the viewable display of the digital camera." This additional limitation of claim 1 is independently distinguishable from both Stephenson and the subject matter defined by claim 7.

Stephenson discloses a printer that prints images by illuminating photosensitive media with a light image from a liquid crystal display of a camera. In particular, the printer disclosed by Stephenson forms a light-tight seal around a camera display where light is emitted from the camera display through a printing optic of the printer onto photosensitive paper. Therefore, as disclosed by Stephenson, the display of its camera is not viewable when its printer is connected to the camera via its communication link. Accordingly, Stephenson does not disclose or suggest a photoprinter (connected to a digital camera via a communication link) that is operative to control a "viewable" display of the digital camera, as required by claim 1. Thus, claim 1 is patentably distinguishable from Stephenson, not only because Stephenson fails to teach or suggest a photoprinter capable of processing digital files independent of an external host device, but also because of the total absence in Stephenson of any disclosure or suggestion of a photoprinter operative to control the viewable display of a digital camera when the photoprinter is connected to the digital camera via a communication link.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claim under consideration, *Alco Standard Corp. v. TVA*, *supra*. In view of the failure of Stephenson to disclose, for example, a photoprinter configuration comprising a photoprinter capable of processing digital files independent of an external host device and

operative to control a viewable display of a digital camera connected to the photoprinter via a communication link, Stephenson does not disclose each element of claim 1. Therefore, Stephenson does not anticipate the photoprinter configuration defined by claim 1. Accordingly, the photoprinter configurations defined by claim 1, as well as claims 2 and 6 which are dependent thereon, are not anticipated by Stephenson, and the rejection of claims 1, 2 and 6 under 35 U.S.C. §102 should be reversed.

5. **The Method Of Claim 8 Is Independently Patentable**

Claim 8, which is dependent on independent claim 7, further requires the instructions transmitted in claim 7 to be operative to preview digital photographs on the viewable display.

The printing apparatus disclosed by Stephenson forms a light-tight seal around a camera display, wherein light is emitted from the camera display through a printing optic of the printer onto photosensitive paper. Therefore, as disclosed by Stephenson, the display of its camera is not even viewable when its printer is connected to the camera via its communication link. Accordingly, something cannot be “previewed” if it cannot even be viewed. Since Stephenson is totally devoid of any disclosure or suggestion of transmitting instructions from a photoprinter to a digital camera that are operative to preview digital photographs on a viewable display of the digital camera when it is connected to the photoprinter via a communication link, it necessarily follows that the invention defined by claim 8 is not anticipated by Stephenson.

As noted above, anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claim under consideration, *Alco Standard Corp. v. TVA*, *supra*. In view of the shortcomings of Stephenson noted above, Stephenson does not disclose each element of claim 8. Therefore, Stephenson does not anticipate the method defined by claim 8, and the rejection of claim 8 under 35 U.S.C. §102 should be reversed.

6. **The Method Of Claim 9 Is Independently Patentable**

Claim 9, which is dependent on independent claim 7, adds the additional limitation that the instructions transmitted in claim 7 are operative to present a user interface on the viewable display. As noted above, in the system disclosed by Stephenson, the display of the digital camera is not even viewable when the printer is connected to the camera. If the display is not viewable, a user could not interface with anything on the display. Accordingly, there is no disclosure or suggestion in Stephenson of transmitting instructions from a photoprinter to a digital camera that are operative to present a user interface on the viewable display. Hence, the method defined by claim 9 is not anticipated by Stephenson, and the rejection of claim 9 under 35 U.S.C. §102 should be reversed.

7. **The Photoprinter Configuration Of Claim 2 Is Independently Patentable**

According to claim 2, which is dependent on independent claim 1, the photoprinter is further operative to direct the results from a user's input to the selection mechanisms. In rejecting this claim, the Examiner asserted that an active socket, a passive socket and a camera head of the camera in Stephenson are "selection mechanisms." In Stephenson, the sockets secure and align a printer over a camera display by cooperating with corresponding latches on the printer, while the camera head captures images. Furthermore, the active socket incorporates circuitry for communicating with the printer, which allows printer electronics to transmit control signals to camera electronics, thereby allowing the printer electronics to control turning the display on and off (e.g., in response to an operator signaling the start of printing).

Therefore, in the system of Stephenson, once a user arguably provides an input to one of its asserted "selection mechanisms," it is its camera that is operative to direct any results, not its printer. Accordingly, Stephenson lacks any teaching or suggestion of a digital camera having one or more selection mechanisms, wherein the photoprinter is operative to direct results from a user's inputs to the selection mechanisms, and necessarily cannot anticipate claim 2.

In view of the foregoing, the photoprinter configuration defined by claim 2 is not anticipated by Stephenson, and the rejection of claim 2 under 35 U.S.C. §102 should be reversed.

8. **The Method Of Claim 10 Is Independently Patentable**

Claim 10 requires, in addition to the limitations of claim 7 upon which it is dependent, transmitting a plurality of instructions from a photoprinter to a digital camera connected to the photoprinter via a communication link, wherein the instructions are operative to direct an operation of the photoprinter based on input to selection mechanisms of the digital camera. For reasons similar to those called out with respect to claim 2 above, input to the asserted “selection mechanisms” of the Stephenson camera at best direct an operation of the camera, not its printer. Stephenson therefore fails to teach or disclose transmitting a plurality of instructions from a photoprinter to a digital camera connected to the photoprinter via a communication link, wherein the instructions are operative to direct an operation of the photoprinter based on input to selection mechanisms of the digital camera, and does not anticipate the method for controlling a digital camera as defined by claim 10. Accordingly, the method defined by claim 10 is not anticipated by Stephenson, and the rejection of claim 10 under 35 U.S.C. §102 should be reversed.

9. **The Method Of Claim 12 Is Independently Patentable**

Claim 12 adds to the limitations of claim 10 the limitation that the instructions are operative to modify a printed rendition of digital photographs based on input to the selection mechanisms. Stephenson is quite simply wholly devoid of any teaching or suggestion of modifying a printed rendition of digital photographs based on input to selection mechanisms. At best, Stephenson merely discloses turning on and off a display of its camera (for exposing photosensitive media) based on input to its asserted "selection mechanisms." As Stephenson does not disclose each element of claim 12, Stephenson does not anticipate the method for controlling a digital camera as defined by claim 12.

Accordingly, the method defined by claim 12 is not anticipated by Stephenson, and the rejection of claim 12 under 35 U.S.C. §102 should be reversed.

B. **The Claimed Printer Configurations Are Nonobvious Over Stephenson In View of Taniguchi et al.**

The printer configurations as defined by claims 13-23 are nonobvious over and patentably distinguishable from Stephenson in view of Taniguchi et al.

1. **The Invention**

As set forth above, the present invention is directed to printer configurations. As defined by claim 13, the printer configuration comprises a host computer; a peripheral device; and a stand-alone printer connected via a communication link to the host computer and the peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host to the peripheral device and as a pass-through device such that the host computer may initiate requests to the peripheral device. As defined by claim 21, the printer configuration comprises a universal serial bus; a stand-alone printer connected to the universal serial bus as a universal serial bus host; and a peripheral device connected to the universal serial bus as a universal serial bus device, the device being subordinate to the stand-alone printer.

2. **The Rejection**

Admitting that Stephenson fails to teach a printer being operable as a client to a host computer, the Examiner asserted that Taniguchi et al. teach that it is well-known in the art to make a printer operate as a client to a host computer, and that it would have been obvious to provide the system taught by Stephenson with a host and “allowing the printer to operate as a host to the printer (sic).”

3. **The Printer Configurations of Claims 13-20 Are Nonobvious Over Stephenson In View of Taniguchi et al.**

No prima facie case of obviousness has been established with respect to any of claims 13-23, whereby the rejection under 35 U.S.C. §103 should be reversed.

As defined by claim 13, the claimed printer configurations comprise a host computer, a peripheral device, and a stand-alone printer connected via a communication link to the host computer and the peripheral device. The stand-alone printer is operable as a client to the host computer, and as a host for the peripheral device, and as a pass-through device such that the host computer may initiate requests to the peripheral device.

Stephenson discloses printing from a liquid crystal display on a camera. Taniguchi et al. disclose a network print system for allowing a printer or printers to select a host. Appellants find no teaching by Stephenson, alone or in combination with Taniguchi et al., of a stand-alone printer connected via communication link to a host computer and a peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a pass-through device such that the host computer may initiate requests to the peripheral device.

The Examiner asserted that Taniguchi et al. teach that it is well-known in the art to make a printer operate as a client to a host computer. The Examiner further asserted that it would have been obvious to one of ordinary skill in the art to modify a system taught by Stephenson to allow “the printer to operate as a host to the printer (sic).” Nevertheless, the

Examiner made no showing or teaching of a printer operating as a host for a peripheral device and as a passthrough device such that the host computer may initiate requests to the peripheral device.

To establish prima facie obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka, supra*. In view of the failure of Stephenson and Taniguchi et al., alone or in combination, to teach, disclose or suggest a photoprinter configuration comprising, *inter alia*, a stand-alone printer (defined in the specification as a printer capable of processing and printing digital files independent of an external host device) connected via a communication link to a host computer and a peripheral device, wherein the stand-alone printer is operable as a host for the peripheral device and as a passthrough device such that the host computer may initiate requests to the peripheral device, the combination of Stephenson and Taniguchi et al. do not support the rejection under 35 U.S.C. §103. Thus, the combination of Stephenson and Taniguchi et al. do not render obvious the printer configurations defined by the claim 13.

Moreover, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet, supra*. In fact, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Appellants. See *In re Dance, supra*. Appellants find no teaching, suggestion or motivation for combining the network print system of Taniguchi et al. for allowing a printer or printers to select a host computer with the LCD camera printer apparatus of Stephenson. In particular, for example, there appears to be no motivation for even having a host in the camera and compact optical printer system of Stephenson

Accordingly, the printer configurations as defined by claims 13-20 are nonobvious over and patentably distinguishable from the combination of Stephenson and Taniguchi et al., and the rejection of claims 13-23 under 35 U.S.C. §103 should be reversed.

4. **The Printer Configuration Of Claim 18 Is Independently Patentable**

Dependant claim 18 which is dependent on claim 13, further requires the communication link to be universal serial bus and requires a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal serial bus device controller and universal serial bus host controller.

As noted above, Stephenson discloses liquid crystal display printing on a camera apparatus. Taniguchi et al. disclose a network print system for allowing a printer or printers to select a host. Appellants find no teaching by Stephenson, alone or in combination with Taniguchi et al., of a stand-alone printer connected via a communication link to a host computer and a peripheral device, wherein the communication link includes a universal serial bus and the stand-alone printer also includes a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal serial bus device controller and universal serial bus host controller.

The Examiner asserted that Taniguchi et al. teach that it is well-known in the art to make a printer operate as a client to a host computer. The Examiner further asserted that it would have been obvious to one of ordinary skill in the art to modify a system taught by Stephenson to allow “the printer to operate as a host to the printer (sic).” However, the Examiner has made no assertions that Stephenson shows or teaches a stand-alone printer that comprises a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal serial bus device controller and universal serial bus host controller.

In view of the failure of Stephenson and Taniguchi et al., alone or in combination, to teach, disclose or suggest a photoprinter configuration comprising, *inter alia*, a stand-alone printer comprising a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal serial bus device controller and universal serial bus host controller, the combination of Stephenson and Taniguchi et al. do not support the rejection under 35 U.S.C. §103. Thus, the combination of Stephenson and Taniguchi et al. do not render obvious the printer configuration defined by claim 18. Accordingly, the printer configuration as defined by claim 18 is nonobvious over and patentably distinguishable from the combination of Stephenson and Taniguchi et al., and the rejection of claim 18 under 35 U.S.C. §103 should be reversed.

5. **The Printer Configuration Of Claim 19 Is Independently Patentable**

Claim 19 requires, in addition to the limitations of claim 18 upon which it is dependent, that the universal serial bus device controller and universal serial bus host controller share one or more FIFOs.

To establish prima facie obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka, supra*. No assertions have been made with respect to a particular aspect of either Stephenson or Taniguchi et al. teaching or suggesting that a universal serial bus device controller and universal serial bus host controller share one or more FIFOs. Since Appellants find no teaching by Stephenson, alone or in combination with Taniguchi et al., of the universal serial bus device controller and universal serial bus host controller sharing one or more FIFOs, the combination of Stephenson and Taniguchi et al. do not support the rejection under 35 U.S.C. §103. Thus, the combination of Stephenson and Taniguchi et al. do not render obvious the printer configuration defined by the claim 19.

Accordingly, the printer configuration as defined by claim 19 is nonobvious over and patentably distinguishable from the combination of Stephenson and Taniguchi et al., and the rejection of claim 19 under 35 U.S.C. §103 should be reversed.

6. **The Printer Configuration Of Claim 21 Is Independently Patentable**

Claim 21 is independently patentable, as are claims 22 and 23 which depend from claim 21. According to claim 21, a printer configuration comprises a universal serial bus; a stand-alone printer connected to the universal serial bus as a universal serial bus host; and a peripheral device connected to the universal serial bus as a universal serial bus device, the peripheral device being subordinate to the stand-alone printer.

Stephenson discloses printing from a liquid crystal display on a camera. Taniguchi et al. disclose a network print system for allowing a printer or printers to select a host. However, Appellants find no teaching or suggestion by Stephenson, alone or in combination with Taniguchi et al., of a printer configuration comprising a stand-alone printer connected to a universal serial bus, wherein the stand-alone printer is a universal serial bus host and a peripheral device connected to the universal serial bus as a universal serial bus device is subordinate to the stand-alone printer. To the contrary, the specific teachings of Stephenson and Taniguchi et al. disclose a printer in a subordinate role (i.e., subordinate to a host computer, wherein the printer operates as a device, and the computer is the host).

References relied upon to support a rejection under 35 U.S.C. §103 must also provide an enabling disclosure, i.e., it must place the claimed invention in the possession the public, *In re Payne, supra*. In view of the failure of the cited references to teach or suggest a printer configuration comprising a universal serial bus; a stand-alone printer connected to the universal serial bus as a universal serial bus host; and a peripheral device connected to the universal serial bus as a universal serial bus device, wherein the peripheral device is subordinate to the stand-alone printer, the combination of Stephenson in view of Taniguchi et

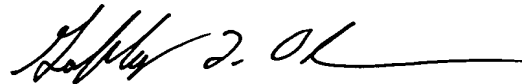
al. do not provide an enabling disclosure of the printer configurations of claim 21. In particular, they do not place the claimed invention in the possession of the public. Thus, the combination of Stephenson in view of Taniguchi et al. do not support a rejection of claim 21, or claims 22 and 23 dependent thereon, under 35 U.S.C. §103.

Accordingly, the printer configurations defined by claim 21, and claims 22 and 23 dependent thereon, are nonobvious over and patentably distinguishable from the combination of Stephenson and Taniguchi et al., and the rejection of claims 21-23 under 35 U.S.C. §103 should be reversed.

VI. CONCLUSIONS

For the reasons set forth in detail above, the printer configurations and methods for controlling a digital camera, as defined by claims 1-2 and 6-23 are not anticipated by, and are nonobvious over and patentably distinguishable from, Stephenson, whether alone or in combination with Hanada or Taniguchi et al. Accordingly, the rejections of claims 1-2 and 6-23 under 35 U.S.C. §§102 and 103 should be reversed. Favorable action by the Board is respectfully requested.

Respectfully submitted,



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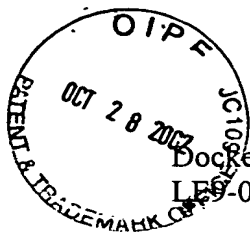
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APPENDIX

1. A photoprinter configuration, comprising:
 - a) a digital camera comprising a viewable display and one or more selection mechanisms; and
 - b) a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the digital camera.
2. The photoprinter of claim 1, wherein the photoprinter is further operative to direct the results from a user's inputs to the selection mechanisms.
6. The photoprinter of claim 1, further comprising means for controlling the digital camera by the photoprinter.
7. A method for controlling a digital camera, comprising the steps of:
 - a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media;
 - b) obtaining a digital camera comprising a viewable display and one or more selection mechanisms;
 - c) connecting the digital camera to the photoprinter via a communication link;
 - d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and
 - e) controlling the digital camera by the photoprinter in accordance with the plurality of instructions.
8. The method of claim 7, wherein the instructions are operative to preview digital photographs on the viewable display.

9. The method of claim 7, wherein the instructions are operative to present a user interface on the viewable display.
10. The method of claim 7, wherein the instructions are operative to direct an operation of the photoprinter based on input to the selection mechanisms.
11. The method of claim 10, wherein the instructions are further operative to select digital photographs for printing based on input to the selection mechanisms.
12. The method of claim 10, wherein the instructions are further operative to modify a printed rendition of digital photographs based on input to the selection mechanisms.
13. A printer configuration, comprising:
 - a) a host computer;
 - b) a peripheral device;
 - c) a stand-alone printer connected via a communication link to the host computer and the peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a passthrough device such that the host computer may initiate requests to the peripheral device.
14. The printer configuration of claim 13, wherein the stand-alone printer is a photoprinter.
15. The printer configuration of claim 13, wherein the peripheral device is a digital camera.
16. The printer configuration of claim 13, wherein the stand-alone printer comprises a means for receiving and sending data via the communication link.
17. The printer configuration of claim 13, wherein the communication link is a universal serial bus.

18. The printer configuration of claim 17, wherein the stand-alone printer comprises a universal serial bus device controller, a universal serial bus host controller, and a processor interface operative to control the universal serial bus device controller and universal serial bus host controller.
19. The printer configuration of claim 18, wherein the universal serial bus device controller and universal serial bus host controller share one or more FIFOs.
20. The printer configuration of claim 17, wherein the stand-alone printer comprises a universal serial bus hub.
21. A printer configuration, comprising:
 - a) a universal serial bus;
 - b) a stand-alone printer connected to the universal serial bus as a universal serial bus host; and
 - c) a peripheral device connected to the universal serial bus as a universal serial bus device, said peripheral device being subordinate to the stand-alone printer.
22. The printer configuration of claim 21, wherein the peripheral device is a digital camera.
23. The printer configuration of claim 21, wherein the stand-alone printer is a photoprinter.



Docket No: 21043-87

LE9-00-044

CERTIFICATE OF MAILING

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Bonnie S. Dunn

PATENT

-EXPEDITED PROCESSING

AMENDMENT UNDER 37 C.F.R. 1.116-

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Luciano et al. :
Serial No.: 09/609,891 : Group Art Unit: 2624
Filed: July 5, 2000 : Examiner: G. Garcia
For: **Photoprinter Control of
Peripheral Devices** :

SECOND AMENDMENT UNDER 37 C.F.R. 1.116

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Concurrent with the filing of an Appeal Brief, Applicants request amendment of the present application as follows:

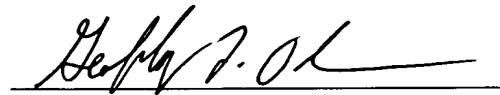
In the Claims:

Please cancel claims 3-5.

REMARKS

The present amendment is submitted to reduce the issues on appeal. Claims 3-5 are cancelled. A Version With Markings Showing Changes Made is attached. As these changes do not involve any introduction of new matter and do not raise any new issues on appeal, but rather reduce the issues on appeal by reducing the number of claims, entry is believed to be in order and is respectfully requested.

Respectfully submitted,



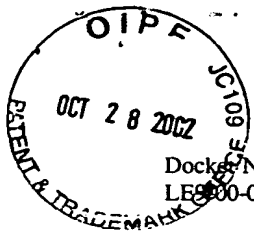
Geoffrey L. Oberhaus, Esq.
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1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202
(513) 977-8623

837681.01

VERSION WITH MARKINGS SHOWING CHANGES MADE

In the Claims:

Please cancel claims 3-5.



Docket No: 21043-87
LE 000-044

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Bonnie S. [Signature]

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Joseph W. Luciano et al. :
Serial No.: 09/609,891 : Group Art Unit: 2624
Filed: July 5, 2000 : Examiner: G. Garcia
For: **Photoprinter Control of** :
Peripheral Devices :

TRANSMITTAL OF APPEAL BRIEF

Assistant Commissioner for Patents
Washington, DC 20231

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Dear Sir:

Submitted herewith in **triplicate** is an Appeal Brief in support of the Notice of Appeal filed by Certificate of Mail on July 18, 2002 and received by the U.S. Patent and Trademark Office on July 23, 2002. The government fee in the amount of \$320.00 for filing the present Appeal Brief is enclosed by check.

Please charge any additional fees required or credit any excess in fees paid in connection with the present communication to Deposit Account No. 04-1133.

Respectfully submitted,

By *Geoffrey L. Oberhaus*

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